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Docket No.: 1349.1329

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Seung-jae LEE et al.

Serial No. 10/649,728

Group Art Unit: 3653

Confirmation No. 5694

Filed: August 28, 2003

Examiner: MORRISON, Thomas A.

For: PAPER PICK-UP DEVICE FOR IMAGE FORMING APPARATUS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed November 10, 2004, having a shortened period for response set to expire on December 10, 2004, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect **Group I, claims 1-23 and 27-35** in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

Insofar as Group II is concerned, it is believed that claims 24-26 are so closely related to elected claims 1-23 and 27-35 that they should remain in the same application. The elected claims 1-23 and 27-35 are directed to a paper pickup device of an image forming apparatus, classified in class 271, subclass 117 and claims 24-26 are drawn to a method of picking up paper sheets having different strengths in an image forming apparatus, classified in class 271, subclass 110. There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing both method and product claims in the same field of technology. While it is noted that the Examiner has identified different classifications for the product and method claims, it is believed that classification is not conclusive on the question of restriction. It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the Examiner at this

time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Group II claims by filing a divisional application.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required.

Even if the Examiner considers claims 24-26 to be a separate invention from claims 1-23 and 27-35, the Applicants respectfully request the Examiner to consider claims 1-23 and 27-35 (Group I) and 24-26 (Group II) together.

III. Conclusion

Upon review of references involved in this field of technology, when considering that the method recited by the Group II claims is directed to a method of picking up paper sheet having different strengths in an image forming apparatus, and elected claims 1-23 and 27-35 are directed to a paper pickup device of an image forming apparatus, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

STAAS & HALSEY LLP

Date: December 10, 2004

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